

REMARKS

This Amendment is in response to the outstanding Official Action mailed March 18, 2003, the shortened statutory period for response having expired on June 18, 2003. In this regard, Applicants submit herewith a three-month extension petition resetting the deadline for responding to the Official Action to and including September 18, 2003. In view of the below remarks, reconsideration of the Examiner's rejection is respectfully requested.

The Examiner has objected to claim 72 as containing a typographical error in that the term "plan" should be the term "plane". Applicants have amended the aforementioned claim to overcome the Examiner's objection.

The Examiner has rejected claims 43-45, 48, 50-52, 55, 57-59, 62 and 64-66 under 35 U.S.C. § 102(b) as being anticipated by *Matsen, III et al.*, United States Patent No. 4,979,949; and claims 1-3, 5, 8, 9, 11 12, 16-18, 21, 23, 24, 28, 30-33 and 36-39 under 35 U.S.C. § 103 (a) as being obvious over *Morawa et al.*, United States Patent No. 5,788,700 in view of *Matsen, III et al.*, United States Patent No. 5,690,635. Of these claims, claims 1, 16, 28, 43, 50, 57 and 64 have been presented in independent form.

In Applicants' prior Amendment of December 17, 2002, independent claims 1, 16 and 28 were distinguished over *Morawa et al.* by the limitation of the alignment means being presented in means-plus-function format. Specifically, these three independent claims all recite "alignment means for locating the resection guide relative to the anchoring means." As previously pointed out to the Examiner, and as acknowledged by the Examiner, one must construe this means-plus-function limitation by looking to the specification as to the corresponding structure described therein, and equivalents

thereof. Accordingly, the Examiner may not disregard the structure disclosed in Applicants' specification when rendering a patentability determination.

The Examiner contends that these claims are not presented in means-plus-function language by Applicant's use of the modifying term "alignment". Applicants have amended claims 1, 16 and 28 to now recite "means for locating the resection guide relative to the anchoring means". Accordingly, these claims are entitled to interpretation under 35 U.S.C. § 112, sixth paragraph.

By way of example, Applicants' means for locating the resection guide is illustrated in Fig. 5. Specifically, the means 12 includes a first structure which allows the resection guide to be adjusted according to varus-valgus angle relative to the anchoring device 10. A second structure allows the resection guide to be adjusted according to flexion-extension angle relative to the anchoring device 10. Finally, a third structure, as further shown in Fig. 7, allows for proximal-distal positioning of the resection guide relative to the anchoring device 10. As a result of the structures of Applicant's means for locating the resection guide 14 may be positioned in three degrees of freedom, specifically, varus-valgus, flexion-extension and proximal-distal, that is, two rotational and one translational alignment.

There is no disclosure in *Morawa et al.* of any structure for aligning a resection guide relative to an anchoring means which corresponds to or is equivalent to Applicants' claimed means for locating the resection guide. The structure disclosed in Applicants' specification provides not only for translational movement, but also for two rotational movements which is not achievable by the alignment guide disclosed in *Morawa et al.* The Examiner has acknowledged that

this feature is not disclosed in *Morawa et al.* In this regard, it is specifically noted that Applicants' claims limited to the three degrees of freedom including two rotational and one translational are allowable over the prior art of record, including *Morawa et al.* Thus, the proper interpretation of the means for locating the resection guide in Applicants' claims must be a structure which provides three degrees of freedom which are two rotational and one translational. Accordingly, Applicants' claimed means for locating the resection guide clearly distinguishes the rejected claims over *Morawa et al.* which does not disclose any structure to perform these specific degrees of freedom. The Examiner's rejection is therefore considered traverse and should be withdrawn.

Applicants also submit newly proposed claims 74-81, of which claims 74 and 78 have been presented in independent form. Each of these claims include the distinguishing limitation of means for locating the resection guide relative to the anchoring pin. For those reasons noted hereinabove, there is no structure disclosed in *Morawa et al.* corresponding to the means for locating as disclosed by Applicants. Accordingly, claims 74 through 81 are deemed patentable over *Morawa et al.*

Turning to Applicants' independent claims 43, 50, 57 and 64, the Examiner refers to *Matsen, III et al.*, the '949 patent. The Examiner states that the '949 patent teaches a robotic-aided system for surgery which includes a resection guide 215 adapted for guiding a cutting device relative to a patient's bone during arthroplasty. An alignment guide 54 is coupled to the resection guide and includes a first assembly 152 for positioning the resection guide along a translational path and a second assembly 148, 142 for positioning the resection guide along a first rotational path and a second rotational path. A computer navigation system 198 is coupled to the

resection guide. As will be apparent from the following discussion, the Examiner's reliance upon the '949 patent for teaching a translational path is not supported by the reference.

There is disclosed in Figs. 7 and 8 of the '949 patent a robotic assembly 54. The robotic assembly provides six degrees of freedom, see col. 13, lns. 20 et. seq. However, it is clear that all motions of the robotic arm are rotational, as opposed to any linear adjustment. More specifically as to assembly 152, i.e., the lower arm, it is rotatable about rotational axis 150 as stated in the '949 patent as "the lower arm raises and lowers the wrist by rotation around the elbow." Thus, it is clear that the assembly 152 of the '949 patent does not position the resection guide along a translational path as stated by the Examiner. Accordingly, the Examiner's rejection is considered traverse and should therefore be withdrawn.

As requested by the Examiner, Applicants submit herewith a new abstract.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issuance.

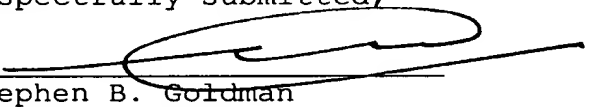
In considering Applicants' within response, Applicants designate the rejected dependent claims as being allowable by virtue of their ultimate dependency upon submittedly allowable independent claims. Although Applicants have not separately argued the patentability of each of the dependent claims, Applicants' failure to do so is not to be taken as an admission that the features of the dependent claims are not themselves separably patentable over the prior art cited by the Examiner.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested Amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: September 17, 2003

Respectfully submitted,

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ABSTRACT

A system for resecting a tibia and femur during arthroplasty includes anchoring devices, a three-way alignment guide attachable to an anchoring device. The alignment guide provides for locating a resection guide in three degrees of freedom, including one translation and two rotations. The resection guide is coupled to a computer navigation system.

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